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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/689,658 | 10/22/2003 | Stuart Weikel | 8932-589-999 | 6494 |

51832 7590 07/25/2006

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| EXAMINER |
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PHILOGENE, PEDRO

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| ART UNIT | PAPER NUMBER |
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3733

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

10/689,658

Applicant(s)

WEIKEL ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/3/04, 10/22/03, 2/5/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Specification

The disclosure is objected to because of the following informalities: in the brief description of the drawings: there is no brief description for FIGS. 4D-4E. Also there is no brief description for FIGS. 8A-8C. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. (6,575,919) in view of Gelpcke (1,852,296).

With respect to claims 1 and 24, Reiley et al disclose a surgical instrument comprising a shaft (30) having longitudinal axis and proximal and distal ends having a length sufficient to create a percutaneous path to bone, a cross-section normal to the longitudinal axis, a tip (35) on the distal end of the shaft a plurality of facets that intersect to form a point for piercing tissue, at least two of the facets intersecting to form an edge for cutting tissue, and at least one other surface adjoining the cutting edge; as best seen in FIG.2, and as set forth in column 45, lines 3-11, wherein the cross section of the shaft varies along the length of the shaft, and a first cross-section of the first location along the length of the shaft has a first area and a second cross-section at a second location along the length of the shaft has a second area, the first area greater

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than the second area, and the second location is situated between the first location and the proximal end of the shaft; as best seen in FIG.1 and 9,11, since the tip is beveled.

It is noted that Reiley et al did not teach of a plurality of surfaces aligned with the longitudinal axis; as claimed by applicant. However, in a similar art, Gelpcke, evidences the use of a device, having a plurality of surfaces aligned with the longitudinal axis for preventing the shaft from turning inside a bore.

Therefore, given the teaching of Gelpcke, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Reiley et al, as taught by Gelpcke, to prevent the device from turning inside the sleeve.

With respect to claims 2-23, the above combination of references teaches all the limitations, as set forth; for example the polygonal cross-section, Gelpcke, line 51,, the cross section having similar shape, Gelpcke (FIG.2) or Reiley et al (FIGS.1,9,11), the planar surface of the facets (FIGS. 1,9) of Reiley et al or FIG.2 of Gelpcke the incline surfaces (FIG.2) of Gelpcke. The third cross section, as best seen near (7) in FIG.2 of Gelpcke, which is non-polygonal and having substantially a curve perimeter, since it is substantially circular; as best seen in FIG.2 of Gelpcke. The shaft having a handle attachment; as best seen in FIG.1 of Reiley et al, the handle is a lobe shape and is releasably secured to the handle attachment; the tip is asymmetrical and the shaft is symmetrical; as best seen in the FIGS., of Reiley et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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| 5,807,317 | 9-1998 | Krech, Jr. |
| 5,490,852 | 2-1996 | Azer et al. |
| 4,543,966 | 10-1985 | Islam et al. |
| 2,919,692 | 1-1960 | Ackermann |
| 3,955,558 | 5-1976 | Fuisz |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
July 17, 2006


PEDRO PHILOGENE
PRIMARY EXAMINER